

REMARKS

The Amendment is submitted in reply to the non-final Office Action dated June 21, 2006. No fee is due in connection with this Amendment. The Director is authorized to charge any additional fees which may be required, or to credit any overpayment to Deposit Account No. 02-1818. If such a withdrawal is made, please indicate the Attorney Docket No. 115808-365 on the account statement.

Claims 1, 3-4, 6, 8, 10-11, 14, 16, 18 and 63-64 are pending in this application. Claims 2, 5, 7, 9, 12-13, 15, 17 and 19-22 were previously canceled. Claims 23-62 were previously withdrawn. In the Office Action, Claims 1, 6 and 14 are rejected under 35 U.S.C. §112, first paragraph, Claims 1, 4, 6, and 14 are rejected under 35 U.S.C. §102 and Claims 1 and 11 are rejected under 35 U.S.C. §103. In response Claim 1 has been amended. This amendment does not add new matter. For the reasons set forth below, Applicants respectfully submit that the rejections should be withdrawn.

In the Office Action, Claims 1, 6 and 14 are rejected under 35 U.S.C. §112, first paragraph, as failing to comply with the written description requirement. Specifically, the Patent Office first alleges that the claims are drawn to the family *Asteracea* but the specification lacks sufficient disclosure to be in possession of the genus at the time of filing. Applicants respectfully disagree.

To satisfy the written description requirement, a patent specification must describe the claimed invention in sufficient detail that one skilled in the art can reasonably conclude that the inventor had possession of the claimed invention. An applicant shows possession of the claimed invention with all of its limitations using such descriptive means as words, structures, figures, diagrams, and formulas that fully set forth the claimed invention. There is no *in haec verba* requirement. Claim limitations can be supported through express, implicit or inherent disclosure.

For example, it is known in the art that there exist many species of plants in the *Asteracea* family that contain sesquiterpene lactones. However, contrary to the Patent Office's assertion that the Applicants' specification only discloses plants of chicory, Applicants actually disclose several species of *Asteracea* that contain sesquiterpene lactones, including, for example, chicory, lettuce, coffee, soja, Jerusalem artichoke, leek, asparagus, extracts thereof and combinations thereof. See, specification, page 7, lines 20-29. Furthermore, because the specification teaches a number of plant materials containing one or more prebiotic fibers and phytochemical agents

capable of inhibiting enzyme activity, other similar types of plant material known by the skilled artisan can be used in accordance with the present claims.

The Patent Office next alleges that claims 6 and 14 recite to “chicory extract” but the specification fails to set forth a representative number of extract examples in order to verify possession. The Patent Office attempts to justify this allegation by claiming that because numerous extraction techniques exist, numerous types of chicory extracts are possible.

Regarding this written description requirement, Applicants respectfully submit that one having ordinary skill in the art would understand that Applicants possessed the claimed subject matter at the time of filing Applicants’ specification. For example, Applicants disclose multiple extraction methods to attain a broad enough range of chicory extract samples to compare effectiveness of the extracts. See, specification, page 7, line 30 to page 8, lines 22. Additional methods of extraction are known and understood by the skilled artisan.

Further, the MPEP states that there are situations where minimal disclosure of species adequately supports the genus. See, MPEP 2163.05, *In re Herschler*, 591 F.2d 693, 697, 200 USPQ 711, 714 (CCPA 1979) (disclosure of corticosteroid in DMSO was sufficient to support claims drawn to a method of using a mixture of a “physiologically active steroid” and DMSO because the “use of known chemical compounds in a manner auxiliary to the invention must have a corresponding written description only so specific as to lead one having ordinary skill in the art to that class of compounds.”). Here, since chicory extract, a known chemical compound, is only a preferred plant material for accomplishing the inventive aspects of the claimed invention, its attainment or extraction is a “manner auxiliary to the invention.” Additionally, since Applicants’ disclosure provides numerous examples of chicory extracts and methods of extraction, Applicants provided sufficient detail to identify the “class of compounds” to one having ordinary skill in the art. In light of these disclosures and examples in the as-filed specification, one having ordinary skill in the art could reasonably conclude that the Applicants had possession of the claimed subject matter at the time of filing.

Based on at least these noted reasons, Applicants believe that Claims 1, 6 and 14 fully comply with 35 U.S.C. §112, first paragraph. Accordingly, Applicants respectfully request that the rejection of Claims 1, 6 and 14 under 35 U.S.C. §112, first paragraph, be withdrawn.

In the Office Action, Claims 1, 4, 6 and 14 are rejected under 35 U.S.C. 102(b) as being anticipated by U.S. Patent 5,592,033 to Anantharaman et al. (“*Anantharaman*”). Applicants

believe this rejection is improper and respectfully traverse it for at least the reasons set forth below.

Applicants have amended independent Claim 1 to recite, in part, a thermally processed plant material. The amendment is supported in the specification, for example, at page 5, lines 19-30. Applicants respectfully submit that the cited reference fails to disclose or suggest all of the claimed elements of independent Claim 1, for which dependent claims 6 and 14 derive, and independent claim 11, for which dependent claims 14 derives. For example, *Anantharaman* fails to disclose or suggest a thermally processed plant material as recited, in part, by independent Claims 1 and 11. The Patent Office even admits the same. See, Office Action, page 5, lines 25-26. This thermal processing enriches the plant material used, which contains sesquiterpene lactones that are thermally stable and maintain themselves in the composition after thermal processing.

By contrast, *Anantharaman* discloses gelatinizing the composition ingredients, including the natural plant material containing sesquiterpene lactones, to improve the palatability of the finish product but destroy the sesquiterpene lactones as well. See, *Anantharaman*, column 2, lines 25-45 and column 7, lines 30-35. Though *Anantharaman* may provide some benefit to mammals, it cannot provide the benefits in accordance with the Applicants' claimed invention because, by destroying the sesquiterpene lactones during the gelatinizing process, *Anantharaman* removes the elements necessary to inhibit cyclooxygenase activity and therefore inhibit inflammation in mammals.

For the reasons discussed above, Applicants respectfully submit Claims 1, 4, 6 and 14 are novel, nonobvious and distinguishable from the cited reference. Accordingly, Applicants respectfully request that the rejections of Claims 1, 4, 6 and 14 under 35 U.S.C. §102 be withdrawn.

In the Office Action, Claims 1 and 11 are rejected under 35 U.S.C. 103(a) as being unpatentable over *Anantharaman* in view of U.S. Patent 6,645,534 to Hermand ("*Hermand*"). Applicants believe this rejection is improper and respectfully traverse it for at least the reasons set forth below.

Applicants respectfully submit that there is no suggestion or motivation to combine *Anantharaman* and *Hermand* to obtain the rejected claims because the cited references (1) are directed to unrelated inventions and (2) teach away from each other. As a result, one having

ordinary skill in the art would not be motivated to modify or combine the cited references to arrive at the present claims.

For example, *Anantharaman* is directed to providing a gelatinized cereal product capable of providing beneficial effects to the gastro-intestinal tract of humans and pets. See, *Anantharaman*, column 1, lines, 7-17. The reference also fails to disclose use of phytochemical agents necessary to inhibit inflammation in a mammal, namely sesquiterpene lactones. *Hermand*, by contrast, is directed to a toothpaste or mouthwash capable for use in the oral cavity for inhibiting gum inflammation and dental plaque through anti-inflammatory and anti-microbial properties in its product. See, *Hermand*, column 1, lines 25-30. Additionally, by disclosing the anti-inflammatory properties in its invention, *Hermand* suggests the use of the requisite phytochemical agents, namely sesquiterpene lactones, necessary to inhibit inflammation.

Moreover, the cited references teach away from each other because *Anantharaman* discloses a gelatinizing process that destroys sesquiterpene lactones necessary for anti-inflammatory effects while *Hermand* inherently needs these lactones to accomplish the anti-inflammatory properties claimed. This is clearly evident where *Anantharaman* desires the lactone removal to remove the bitter flavor notes associated with the chemical and make the finished product more palatable to the consumer. See, *Anantharaman*, column 2, lines 25-35. By contrast, *Hermand* claims its invention's anti-inflammatory effects as an inventive aspect. See, *Hermand*, claim 1.

The Federal Circuit has held that if the proposed modification would render the prior art invention being modified unsatisfactory for its intended purpose, then there is no suggestion or motivation to make the proposed modification. *In re Gordon*, 733 F.2d 900, 221 USPQ 1125 (Fed.Cir. 1984). Applied here, removing sesquiterpene lactones from the *Hermand* invention would remove the inflammatory properties, making the invention unsatisfactory for inhibiting gum inflammation. Likewise, adding sesquiterpene lactones back into the *Anantharaman* invention would bring back the corresponding bitter notes, making the invention less satisfactory for increasing palatability to the consumer.

For the reasons above, the combination of *Anantharaman* in view of *Hermand* is improper and thus, fails to render the claimed subject matter obvious for at least these reasons. Accordingly, Applicants respectfully request that the obviousness rejection with respect to Claims 1 and 11 be reconsidered and rejection be withdrawn.

Applicants note for the record that Claims 63-64 have not been rejected. Thus, Applicants respectfully request that the record reflect that these claims are allowed.

For the foregoing reasons, Applicants respectfully request reconsideration of the above-identified patent application and earnestly solicit an early allowance of same.

Respectfully submitted,

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Dated: September 20, 2006